

SK



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

8V

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/839,161 04/22/97 NEWTON

W

EXAMINER

PM82/0712

EUGENE S STEPHENS
EUGENE STEPHENS & ASSOCIATES
56 WINDSOR STREET
ROCHESTER NY 14605

ART UNIT	PAPER NUMBER
----------	--------------

3634

21

DATE MAILED:

07/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Art Unit: 3634

The response filed June 23, 2000 is acknowledged. The response alleges that the Appeal Brief filed April 17, 2000 is in compliance with 37 CFR 1.192(c) contrary to the examiner's assertions in the communication of June 12, 2000 and as such there is nothing further to do on appellants' part.

Appellants' allegations to the contrary notwithstanding, the Appeal Brief of April 17, 2000 remains *not in compliance* with 37 CFR 1.192(c) for the reasons previously advanced in the Office communication of June 12, 2000, Paper No. 19. In this regard, it is noted that appellants clearly indicate that the claims do not stand or fall together. See Item 7 on page 5 of the Appeal Brief. However, appellants then proceed to argue various claims of each rejection in groups instead of each claim separately as required. For example, see pages 6 and 7. 37 CFR 1.192(c)(7) requires appellants to perform two affirmative acts in the brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. Appellants must state (A) that the claims do not stand or fall together *and* (B) present arguments why the claims subject to the same rejection are separately patentable. As per above, where appellants include the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together, i.e., are separately patentable, yet does not offer argument in support thereof in the "Argument" section of the brief, the brief is to be held in non-compliance as per 37 CFR 1.192(d). Note *Ex parte Schier*, 21 USPQ2d 1016 (BPAI 1991); *Ex parte Ohsumi*, 21 USPQ2d 1020 (BPAI 1991) and MPEP 1206.

Art Unit: 3634

The statement made in Item 7 on page 5 of the Appeal Brief makes it very clear that appellants consider each claim of a respective ground of rejection to be separately patentable. However, appellants then proceed to argue these claims together in groups. For example, for the Section 102 rejection based on Haas, appellants state that claims 1-11, 29, 30, 32-34, 39-44, 46-48, 53-58, 60-63, and 67-73 do not stand or fall together. However, instead of arguing each of these "separately patentable" claims individually, appellants proceed to argue the patentability of these claims grouped as follows: 1, 2-3, 4-6, 7-11, 29, 30, 32-34, 39, 40, 41, 42, 43, 44, 46, 47-48, 53-58 and 60, 61-63, 67, 68, 69, 70-72, and 73. It can be readily seen that claims 3, 5, 6, 8, 9, 10, 11, 33, 34, 48, 54, 55, 56, 57, 58, 60, 62, 63, 71, and 72 have not been separately argued even though they have been stated to stand or fall separately, i.e., to be separately patentable. Accordingly, it is clear that appellants have not performed the two requisite steps and as such the Appeal Brief is in non-compliance since appellants have failed to present any argument as to why these claims are separately patentable.

With respect to the remarks made in the first paragraph of page 2, 37 CFR 1.192(c)(5) makes it very clear that appellants must provide an argument for each claim considered to stand or fall separately.

With respect to the remarks made in the second paragraph of page 2, failed attempts to place an application in condition for allowance by Examiner's Amendment have no bearing on the "compliance" of a Brief under 37 CFR 1.192.

Art Unit: 3634

Appellants' TIME LIMIT for response of ONE (1) MONTH CONTINUES to run from the mailing date of the Notification of Non-Compliance, i.e., June 12, 2000. To avoid dismissal of the appeal, appellants must file a new complete brief (in triplicate) that fully complies with 37 CFR 1.192(c). Extensions of time under 37 CFR 1.136 are permitted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Cohen whose telephone number is (703) 308-2106.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



C. Cohen/ds

July 7, 2000

Daniel P. Stodola
Supervisory Patent Examiner
Group 3600